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08/863,457 05/27/97 KRISHNAMURTHI

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WM01/1105

EXAMINER

NGUYEN, S

ART UNIT

PAPER NUMBER

2664

26

DATE MAILED:

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/863,457

Applicant(s)

Krishnamurthi

Examiner

Steven Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Aug 22, 2001

2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-17 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-14 is/are rejected.

7) ☒ Claim(s) 15-17 is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-3, 6, 8, 9, and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spartz (USP 5878036) in view of Bolon et al. (USP 5822420).

Spartz discloses a mobile switching center (MSC) 16 connected to a base station sub-system (BSS) 15 via an A-interface (Fig. 1). However, Spartz fails to disclose a step of detecting the occurrence of condition whereby a mobile subscriber attempts to make a call while another party is attempting to call the same mobile

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subscriber and generating a message signal at a mobile switching center for transmitting to the mobile subscriber via base station. In the same field of endeavor, Bolon discloses a method of detecting the occurrence of condition whereby a mobile subscriber attempts to make a call while another party is attempting to call the same mobile subscriber and generating a message signal at a switching center for transmitting to the mobile subscriber via base station (See Fig 3, col 3, lines 3-15).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a signaling protocol as disclosed by Bolon for detecting the occurrence of condition whereby a mobile subscriber attempts to make a call while another party is attempting to call the same mobile subscriber and generating a message signal at a switching center for transmitting to the mobile subscriber via base station into Spartz's communication system. The motivation/suggestion would have been to notify the end points and correct the procedure for establishing a telephone call in a communication system.

3. Claims 4-5, 7, 10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spartz and Bolon as applied to claims 1, 6 and 11 above, and further in view of Baldwin (USP 5,633,868).

Spartz and Bolon do not explicitly recite that the paging signal and the page message signal are Alert With Information Message Signals.

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Baldwin shows transmitting Alert With Information Message Signals between a wireless gateway and a subsystem of a CDMA wireless network (col. 10, lines 20-24, and Fig. 4). To use Alert With Information Message Signals would have been obvious to one of ordinary skill in the art because Alert With Information Messages have been widely used to represent incoming calls and other data from a base station to a mobile unit over a voice channel.

Response to Arguments

4. Applicant's arguments filed 8/24/2001 have been fully considered but they are not persuasive.

In response to pages 2-3, In response to applicant's argument that Bolon is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Bolon discloses a method of detecting a glare condition when a mobile initiates a phone call to a local exchange "read on MSC" and a local exchange receives a phone call to the mobile. The local exchange generates a message to notify a mobile when this happen via base station which has an AIR interface bewteen the mobile and Radio base unit (Fig 3). It is same as the claimed

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invention which uses in the mobile telephone communication system. Therefore, it is same field of endeavor.

In response to pages 3-4, In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation is the use of a protocol for notifying the end points of misalignment conditions and a procedure to correct the failure in Bolon's cecular system (See col 3, lines 5-13). Therefore, it would have been obvious to one skill in the art at the time of invention was made to look into Bolon's reference to solve the misalignment conditions in the wireless communication system.

In response to pages 4-5, In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's

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disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to pages 1-7, In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., IS-634 message signals) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to page 7, In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Baldwin discloses a well known paging message "alert with information message" which notifies an incoming call to a user. Therefore, it would have been obvious to one skill in the art at the time of invention was made to recognize that after correcting the misalignment condition, the cellular system generates a paging message to notify an incoming call to the user.

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The teaching of Spartz, Bolon and Baldwin perform the claimed invention.

Therefore, the rejection is remained.

Allowable Subject Matter

5. Claims 15-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Nguyen whose telephone number is (703) 308-8848. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin, can be reached on (703) 305-4366.

The fax phone number for this group is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.

Steven Nguyen
Art Unit 2664
October 29, 2001



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